

AMENDMENTS TO THE DRAWINGS

Page 1-4 are amended to included a label designating them as prior art as requested by the examiner.

REMARKS

Figs. 1-4 are objected to as not including the legend "Prior Art". Replacement Figs. 1-4 are enclosed including such a legend. Reconsideration of the objection to the figures is respectfully requested.

Claim 42 is objected to as including formalities. Claim 42 is amended in light of the remarks in the Office Action. Reconsideration of the objection to claim 42 is respectfully requested.

Claims 1-11, 17-20, 21-31, 37-40 and 41-44 are rejected under 35 USC § 103 as being unpatentable over U.S. Patent 5,736,910 to Townsend, et al. ("Townsend") in view of U.S. Patent 6,212,274 to Ninh ("Ninh").

Claims 12-16 and 32-36 are rejected under 35 U.S.C. § 103 as being unpatentable over Townsend in view of Ninh and further in view of US Patent 4,677,518 to Hershfield ("Hershfield"). Reconsideration of the application in light of the remarks below is respectfully requested.

In order to establish a prima facie case of obviousness the Office Action must show:

1. A combination of the teachings in the prior art that corresponds to the claim limitations; and
2. A motivation in the prior art itself for combining the art as suggested by the examiner.

See, e.g., M.P.E.P. § 706.02(j). Both elements are missing here.

Among the limitations of independent claims 1, 21 and 41 which are neither disclosed nor suggested even in a combination of the art of record are: "a transient voltage suppression device and a frequency compensation device." Similarly, among the limitations of independent claim

43 which are neither disclosed nor suggested even in a combination of the art of record are: “shunting a transient voltage introduced to the circuit using a transient voltage suppression device; and frequency compensating for the shift in frequency caused by the capacitance of the transient voltage suppression device.”

The Office Action agrees that the Townsend reference does not disclose a frequency compensation device and points to Ninh. To begin with, while the Townsend reference does disclose a “modular jack”, the Ninh reference relates to a “line powered modem” and more specifically relates to computer systems employing modems and power circuits for those modems. See, e.g., Ninh column 1, lines 9-11. It is not clear why one with ordinary skill in the art would be interested in looking to the line powered modem disclosure of Ninh when dealing in the art of “connectors” as is claimed.

Moreover, the Examiner specifically references Fig. 7 of Ninh and points to element RV1 as corresponding to the claimed transient voltage suppression device and the elements L1-L2 as corresponding to the claimed frequency compensation device. While these elements appear to have the same positioning and orientation as that shown in the present specification, they perform completely different functions. For example, the Ninh specification makes clear that inductors L1 and L2 form part of a low pass filter circuit. See, Ninh, column 11, lines 32-36. Therefore, even the Ninh reference does not show a frequency compensation circuit as claimed.

Furthermore, there is no motivation shown, in the prior art itself, for combining the two references - as is required. For a motivation, the Office Action simply states it would have been obvious to combine the two references “to reduce cost because use of a frequency compensation device along with a voltage suppressing device allows the capacitor value to perform the same compensation function as larger capacitor.” See Office Action, page 3. Such a motivation

appears to have been impermissibly learned from the present specification and not from the prior art. The inventors of the present application have discovered a way of using low cost, high capacitance diodes by incorporating an extra frequency compensation component in the circuit. This discovery was not known in the art and no piece of the prior art is cited as showing the same.

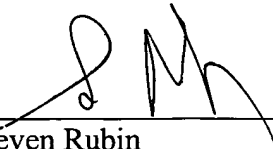
Therefore, it is asserted that independent claims 1, 21, 41, and 43 are patentable over even a combination of Townsend and Ninh. The reference to Hershfield is not cited to show, and does not appear to show, the above-referenced limitations. As such, it is asserted that independent claims 1, 21, 41 and 43 are patentable over even a combination of Townsend, Ninh and Hershfield. Dependent claims 2-20, 22-40 and 44 include the above-referenced limitations for independent claims 1, 21 and 43 respectively, and include additional limitations which, when combined with limitations of independent claims 1, 21 and 43 are also neither shown nor suggested in the art of record. It is asserted that these claims are patentable as well. Reconsideration of the rejection of claims 1-44 under 35 US § 103 is respectfully requested via the remark above.

The director is hereby authorized to charge any deficiency or credit or any overpayment  
to Deposit Account No. 23-2820.

Reconsideration and allowance of all the claims herein are respectfully requested.

Respectfully submitted,

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